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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/992,430 | 11/23/2001 | Vineet Rajgarhia | 00-1237-A | 5475 |

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EXAMINER

PAK, YONG D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1652

22

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,430

Applicant(s)

RAJGARHIA ET AL.

Examiner

Yong D Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6 and 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The response to the Restriction Requirement filed on July 14, 2003, has been entered.

Claims 1-23 are pending.

Election/Restrictions

Applicant's election with traverse of Group I in Paper No. 21 is acknowledged. The traversal is on the ground(s) that Group III is drawn to a method of using the product of Group I. This is not found persuasive because the DNA of Inventions I can be used for the production of the lactate dehydrogenase or in hybridization assays.

The requirement is still deemed proper and is therefore made FINAL.

Claims 2, 5-6 and 16-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 21.

Notice of Possible Rejoinder: The Examiner notes that if claims 1, 3-4 and 7-15 are found directed to an allowable product, then claims 16-23, which are directed to the process of using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also MPEP 821.04, *In re Ochiai*, and *In re Brouwer*). Since process claims 16-23 would be rejoined

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and fully examined for patentability under 37 CFR 1.104, applicants are instructed to amend said claims as deemed necessary according to rejections made against the elected claims.

Information Disclosure Statement

The information disclosure statement filed on November 25, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The following publications have not been considered because copies of the publications were not submitted.

Danner et al. Applied Biochemistry and Biotechnology Vol. 70-72 (1998)

Gunge et al. J. Bacteriol. 145 :382-390 1981.

Ito et al. J. Bacterol. 153 :163-168 (1983)

Naumov et al. 1990, MGG 224 :119-128

Sambrook et al. 1989, Molecular Cloning, 2nd Ed.

Witte et al. J. Basic Microbial. 29:707-716 (1989)

Claim Objections

Claims 7-15 are objected for being drawn to non-elected products, SEQ ID NOs:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3-4, the exact hybridization condition is unclear. Different nucleic acids hybridize to a DNA sequence under different conditions. Therefore, the scope of DNA molecules in claims 3-4 is unclear. This rejection can be overcome by amending the claims to recite a definite condition for the hybridization.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4 and 7-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Rajgarhia et al. The instant claims are drawn to DNA encoding a lactate dehydrogenase from *Kluyveromyces thermotolerans* (ATCC 52709), vector comprising said DNA and yeast cells transformed with said DNA.

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Rajgarhia et al. (U.S. Patent No. 6,485,947) teach a nucleotide sequence encoding a lactate dehydrogenase from *Kluyveromyces thermotolerans* ATCC 52709 (Columns 28-29). Rajgarhia et al. also teach vectors comprising said DNA and yeast transformed with said vector (Columns 28-29). The DNA of Rajgarhia et al. and the DNA of the instant claims are identical since they are both isolated from the same strain of *K. thermotolerans*. Therefore, the teachings of Rajgarhia et al anticipate claims 1, 3-4 and 7-15.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong D. Pak

August 18, 2003



PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
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